UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/070,622 | 03/04/2002 | Achim Kohler | 1999CH017 | 9381 |

25255 7590 02/04/2003

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

| EXAMINER |
|---|
| FORTUNA, JOSE A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1731 | 8 |

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 10/070,622 | Applicant(s) KOHLER ET AL. | |
|---|---|---|---|
| | Examiner José A Fortuna | Art Unit 1731 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *7 and 8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 9-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the restriction is improper because the office has not shown that the groups are classified in different classes nor that they have acquired different status in the art nor different search is required. Also applicants argues that the application of the PCT rules is improper and even if the PCT rules were applied the inventions are linked to be single inventive concept. Applicants go on to state that the application was not restricted in the PCT application. This is not found persuasive because the application is a national stage application under 371, so the PCT rules for lack of unity apply for this case and therefore, there is no requirement in establishing the different classes, the different status nor the different search as required for the US status, See MPEP 1893.03(d) . As for the PCT rules they lack unity because the composition, which is the linking concept, is not novel or obvious over the cited references. The references teach a similar or the same compound(s) for use in different process(es). It is important to notice that in the US practice a composition is not defined by the intended use.

The requirement is still deemed proper and is therefore made FINAL.

***Specification***

2. The disclosure is objected to because of the following informalities: the US Patent No. 2,723,306 mentioned in page 2, line 2, does not concord with its description, i.e., the patent does teach a polyethylene glycol, but a beam current regulator.

Appropriate correction is required.

***Claim Rejections - 35 U.S.C. § 112***

3.The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is vague and indefinite since the meaning of "simultaneously intaglio and offset printer paper or board," is unclear.

***Claim Rejections - 35 U.S.C. § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Column.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-7 and 10-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohringer et al., US Patent No. 5,622,749.

Rohringer et al. teach process of coating a paper or paperboard using a fluorescent brightening agent a auxiliaries, such as dispersing or emulsifying agents, see abstract. Rohringer et al. teach the use of polyethylene glycol having molecular weights above 300, see column 6, lines 25-61. Rohringer et al. teach also that the coating can be added to the substrate by size press and that the substrate can be used for photographic papers, see column 6, lines 49-51. Even though Rohringer et al. are silent with respect to the use of smoothing rolls, they teach that the substrate can be used in photographic papers that are always smoothed/calendered, see cited

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin, can be reached on (703)308-1164. The fax number for this group is (703)305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José A. Fortuna
January 23, 2003

JOSÉ FORTUNA
PRIMARY EXAMINER
ART UNIT 1731

references for evidence(s). Therefore, Rohringer et al. invention seems to have all the limitations of the claims or at least the minor modifications to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

7. Claims 1 and 7-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ploetz et al., US Patent No. 3,779,791..

Ploetz et al. teach a board which is surface finished with polyethylene glycol having an average molecular weight between 1,000 and 6,000, see abstract. Ploetz et al. teach in column 2, lines 39-43, that the impregnated paper is passed between two rolls and then dried. The passing of the web between the rolls would provide some smoothing to the paper. Therefore, Ploetz et al. invention seems to have all the limitations of the claims or at least the minor modifications to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Surface finishing papers or boards."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.